

REMARKS

Claim 3 is rejected under 35 U.S.C. 102(e) as being anticipated by Dynarski et al. (US Patent No. 6,628,671).

Regarding independent claim 3, the Examiner's interpretation of the description of Dynarski et al. needs further clarification in order to distinguish the present invention from this reference. The Examiner's arguments are analyzed based on MPEP guidelines quoted below:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), MPEP 2131. Further, "the identical invention must be shown in as complete details as is contained in the . . . claim", *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), MPEP 2131.

The Examiner alleges that Dynarski et al. teach that "a first one of said radio network subsystems (11) includes a source radio network controller (16) for signaling to said core network or to a target radio network controller (20) in a second one of said radio network subsystems (12) that a handover is required" as recited in claim 3 of the present invention. Dynarski et al. teach (col. 7, lines 5-8) that " when the mobile device 14 goes out of range of the tower 18A the base station 20A signals, using wireless call signalling procedures, to the network access server 24a that the call is going dormant." Dynarski et al. use a model presented in Figure 1 related to a GSM/GPRS (global system for mobile telecommunications/general packet radio service), whereas the present invention uses UMTS (universal mobile telecommunication system) packet network architecture for

describing the invention. Therefore, first, we have to establish the equivalence of terms. From the above quote from Dynarski et al. it follows the Examiner assumes that the base station **20A** of Dynarski et al. corresponds to the "source radio network subsystem" of claim 3 and that the network access server **24A** of Dynarski et al. corresponds to the "core network" or to the "target radio network controller" of claim 3.

If claim 3 of the present invention is read into teaching of Dynarski et al., as alleged by the Examiner, the network access server **24A** of Dynarski et al. then shall send a message "handover is to proceed" back to the base station **20A** because claim 3 of the present invention states that "said core network or said target radio network subsystem signals the source radio network controller that said handover is to proceed". The Examiner alleges that Dynarski et al. in col. 8-12 and in col. 14, lines 29-33 & 40-43 describe this step of sending by the network access server **24A** of Dynarski et al. a message "handover is to proceed" back to the base station **20A**, but the Applicant did not find a description or even hint of that step (explicitly or implicitly) in col. 8-12 and in col. 14, lines 29-33 & 40-43 of Dynarski et al., as alleged by the Examiner.

The logic breaks down even further when the Examiner alleges that "parameters are then transmitted from said source radio network controller to said target radio network controller directly or via the core network without any need for renegotiating said parameters over said air interface between said mobile station and said target radio network controller" as recited in claim 3 of the present invention. Following the established equivalence of terms, the base station **20A** of Dynarski et al. should transmit said parameters. Instead, Dynarski et al. states in col. 7, line 17-19 that "the base station **20B** sends a new set-up message associated

with the device 14 to the network access server 24A." Apparently base stations 20A and 20B of Dynarski et al. are different entities.

Thus Dynarski et al. do not describe all claim limitations of the independent claim 3 of the present invention required the MPEP Rule 2131 quoted above, therefore, claim 1 is novel and non-obvious and is not anticipated by Dynarski et al. under 35 USC Section 102(e).

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Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dynarski et al. (US Patent No. 6,628,671) in view of Corbett (US Patent 6,504,828).

Regarding independent claim 1, the Examiner's interpretation of the description of Dynarski et al. and Corbett patents needs further clarification in order to distinguish the present invention from these references.

MPEP paragraph 2143 states:

"To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

Regarding independent claim 1 of the present invention, the Examiner does not show that the references he quoted contain all

the claim limitations as required by the third criterion (prior art references when combined must teach or suggest all the claim limitations) of the MPEP paragraph 2143 to establish a *prima facie* case of obviousness. This is because the scope of claim 1 is similar to the scope of claim 3 and all considerations regarding claim 3 outlined above are applied to claim 1 which means that Dynarski et al. do not describe several claim limitations of claim 1 (see the discussion of claim 3 above), as alleged by the Examiner.

Even if, in regard to independent claim 1, for the sake of argument only, we consider that it is possible (which is actually not true since the references quoted by the Examiner do not contain all limitations of claim 1) to combine teachings of Dynarski et al. and Corbett to make the present invention obvious, the Examiner does not show that the references he quoted contain suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings to arrive at the subject matter of claim 1 of the present invention as required by the first criterion of MPEP paragraph 2143 quoted above, or to accomplish that without the benefit of hindsight as required by the case law.

Moreover, Dynarski et al. and/or Corbett do not provide teaching or suggestion for the reasonable expectation of success by combining Dynarski et al.'s teaching with the concept of the optimization algorithm of Corbett, as absolutely required by the MPEP paragraph 2143 to establish a *prima facie* case of obviousness.

Withdrawal of the 35 U.S.C. 103(a) rejection of claim 1 is requested.

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Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dynarski et al. (US Patent No. 6,628,671) in view of Corbett (US Patent 6,504,828) and Bark et al. (US Patent 6,445,917).

Regarding claim 2, it is a dependent claim of novel and non-obvious independent claim 1, as shown above. Since claim 2 narrows the scope of novel and non-obvious independent claim 1, non-obviousness of claim 1 will compel non-obviousness of claim 2.

Another way to rebut to the 35 U.S.C.103(a) rejection of claim 2 is by analyzing MPEP guidelines stated in the MPEP Paragraph 2143 and quoted above. Indeed, the Examiner admits the fact that Dynarski et al. and/or Corbet do not teach establishing various optional sets of parameters, only one of which is accepted by a source radio network subsystem, and storing optional sets of parameters wherein a step of transmitting a parameter includes transmitting all optional sets of parameters. The Examiner alleged that Bark et al. exclusively teach certain aspects of claim 2, such that all limitations of claim 2 are described by the prior art references quoted by the Examiner. That is not accurate. For example Buck does not teach (as alleged by the Examiner) establishing various optional sets of parameters, only one of which is accepted by a source radio network subsystem, wherein a step of transmitting a parameter includes transmitting all optional sets of parameters (col. 7, lines 39-42 and 57-58). Moreover, Buck et al. only talk about the possibility of specifying and measuring qualitative and/or quantitative parameters (col. 7, lines 57-58), etc.

Thus, the Examiner does not show that the references he quoted contain all the claim limitations of claim 2 as required by the third criterion (prior art references when combined must

teach or suggest all the claim limitations) of the MPEP paragraph 2143 to establish a *prima facie* case of obviousness.

Also, similarly to the above discussions regarding independent claim 1 (for the sake of argument only), the Examiner does not show that any of the three references he quoted contain suggestion or motivation expressed explicitly, implicitly or even hinted at, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings to arrive at the subject matter of claim 2 of the present invention as required by the first criterion of MPEP paragraph 2143, quoted above. Therefore, it is highly unlikely that somebody of ordinary skill in the art would have been reasonably expected to combine three references (teaching 3 different components of claim 2) quoted by the Examiner and to find the solution claimed by the Applicant without the benefit of hindsight (also as required by the MPEP paragraph 2143 referenced above and by the case law).

Moreover, Dynarski et al., Corbett and/or Bark et al. do not provide teaching or suggestion for the reasonable expectation of success by combining teachings of these three references for generating the present invention, as absolutely required by the MPEP paragraph 2143 to establish a *prima facie* case of obviousness.

Withdrawal of the 35 U.S.C. 103(a) rejection of claim 2 is requested.

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Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dynarski et al. (US Patent No. 6,628,671) in view of Bark et al. (US Patent 6,445,917).

Regarding claims 4, it is a dependent claim of novel and non-obvious independent claim 3, as shown above. Since claim 4

narrows the scope of novel and non-obvious independent claim 3, non-obviousness of claim 3 will compel non-obviousness of claim 2.

Moreover, the scope of claim 4 is similar to the scope of claim 2 and all considerations regarding claim 2 outlined above are applied to claim 4 which means that Bark et al. do not describe several claim limitations of claim 4, as alleged by the Examiner. Also similar considerations regarding applying the guidelines of the MPEP paragraph 2143 described above in regard to claim 2 are also applied to claim 4.

Withdrawal of the 35 U.S.C. 103(a) rejection of claim 4 is requested.

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Two independent claims (network element claim 5 and mobile station claim 8) and dependent claims 6-7 and 9-21 supported by the disclosure of the present invention are introduced for further clarification. These new claims are similar in scope of the original 4 claims and therefore a new search is not necessary.

The rejections of the Official Action of December 2, 2004, having been obviated or shown to be inapplicable, withdrawal thereof is requested, and passage of the claims to issue is earnestly solicited.

Respectfully submitted,

Date: \_\_\_\_\_

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